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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/632,761

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Karl Francis Horlander

RCA 89.567 Div. 2

5042

7590

03/14/2006

Joseph S. Tripoli
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EXAMINER

NATNAEL, PAULOS M

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/632,761	Applicant(s) HORLANDER, KARL FRANCIS	
	Examiner Paulos M. Natnael	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 and 19-29 is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/27/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims **10-18** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-18 of copending Application No. 09/712,539. Although the conflicting claims are not identical, they are not patentably distinct from each other because allowing the invention defined by claim 10 of the instant application would result in an unwarranted timewise extension of the monopoly defined by the invention of claim 10 of Application 09/712,539.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Considering claim **10**,

a) the claimed "receiving said signal including video image information and copy protection information associated with one of a plurality of display formats", is met by limitation a), claim 10 of Patent application # 09/712,539.

b) the claimed "decoding said copy protection information in the received signal, wherein said copy protection information comprises data relating to display formats available for at least one of: i)recording said video image information; and ii)reproducing said recorded video image information", is met by limitation b) of claim 10 of Patent application # 09/712,539.

c) the claimed adaptively selecting a format for displaying said video image information on a display in response to said decoded copy protection information, is met by limitation c) of claim 10 of Patent application # 09/712,539.

d) the claimed processing said video image information using said selected display format, is met by limitation d) of claim 10 of Patent application # 09/712,539.

Except for the limitation "data controlling subsequent copying of said recorded video image information" in limitation b) of the instant application.

Regarding this limitation, it is noted that it would have been obvious to the one of ordinary skill in the art to recognize that the invention in claim 10 of Application 09/712,539 would be able to perform the function since the limitation recited in the

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claimed invention of the instant application is fully described in the application of 09/712,539, and therefore would have been obvious to modify the invention of claim 10 of the instant application to include such a limitation.

Considering claim **11**, the claimed wherein selection of said display format is in response to said decoded copy protection information determining user entitlement to select one of said plurality of available display formats, is met by claim 11 of Patent application # 09/712,539.

Considering claim **12**, the claimed wherein said display format is one of: i) a standard definition format; and ii) a high definition format, is met by claim 12 of Patent application # 09/712,539.

Considering claim **13**, the claimed further comprising the step of recording said video image information in a format determined by said decoded copy protection information on a recording medium, is met by claim 13 of Patent application # 09/712,539.

Considering claim **14**, the claimed further comprising the step of reproducing said recorded video image information in said format determined by said decoded copy

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protection information on a display, is met by claim 14 of Patent application # 09/712,539.

Considering claim **15**, the claimed wherein said video image information of said received signal is transmitted as a digital signal on a first channel, is met by claim 15 of Patent application # 09/712,539.

Considering claim **16**, the claimed method of further comprising the step of receiving ancillary data transmitted on a second channel for controlling processing of said video image data, is met by claim 16 of Patent application # 09/712,539.

Considering claim **17**, the claimed method of wherein said ancillary data is transmitted as an analog video signal, is met by claim 17 of Patent application # 09/712,539.

Considering claim **18**, wherein each of the plurality of picture resolution formats is associated with a respective billing rate and further comprising the step of billing a user at the billing rate associated with a selected one of said plurality of display formats, is met by claim 18 of Patent application # 09/712,539.

Response to Arguments

3. Applicant's arguments, see arguments, filed 12/14/05, with respect to **19-29** have been fully considered and are persuasive. The rejection of August 10, 2005 has been withdrawn.

Allowable Subject Matter

4. Claims 1-9 and 19-29 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paulos M. Natnael whose telephone number is (571) 272-7354. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571)272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paulos M. Natnael
Primary Examiner
Art Unit 2614

March 4, 2006